

## **Remarks**

### **1. Summary of Office Action**

In the Office Action mailed July 12, 2007, the Examiner objected to claim 18 because it depends from itself, and the Examiner objected to claims 19-24 because they depend from claim 18. The Examiner also rejected claims 1-8, 10-11, and 13-16 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Pub. No. 2004/0240656 (Poustchi), which is based on parent provisional application No. 60/473,877. In addition, the Examiner rejected claims 9, 12, and 17-24 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Poustchi in view of U.S. Patent Application Pub. No. 2004/0148395 (Schulzrinne).

### **3. Status of the Claims**

Presently pending are claims 1-24, of which claims 1, 11, and 17 are independent, and the remainder are dependent. Various claims have been amended as follows.

Applicants have amended independent claim 1 to more particularly point out and distinctly claim the subject matter they regard as their invention. Specifically, Applicants have further limited the step of registering the call park number with the server to recite “at a server in the network, creating an association between the call park number and the second user agent by registering the call park number at the server.” Support for this amendment may be found, for example, at page 14, lines 7-9 of the original specification. Similarly, Applicants have further limited the step of establishing a second communication to include “using the association between the call park number and the second user agent, the association being obtained from the server.” Support for this amendment may be found, for example, at page 14, lines 15-18 of the original specification. Applicants have further amended claim 1 to include the limitation recited in claim 7, which depends from claim 1. Applicants have made additional amendments the

claim 1 that more clearly specify the relationships between the recited steps, as well as ensure proper antecedent basis of recited terms. Minor typographical errors have been corrected as well.

Applicants have also amended claims 2, 4, and 5, all of which depend from claim 1, in order to more clearly specify the relationships of the steps of the dependent claims to those of base claim 1, as well as to ensure consistency of antecedent basis of terms. Applicants have also canceled claim 7 (the limitation of claim 7 now being recited in claim 1, as noted above).

Applicants have amended each of claims 11 and 17 to more clearly specify the relationships between the recited steps and to improve readability. The amendments are similar to those describe in connection with claim 1. Additionally, minor typographical errors have been corrected.

Applicants have also amended claims 13 and 14, which depend from claim 11, in order to more clearly specify the relationships of the steps of the dependent claims to those of base claim 11, as well as to ensure consistency of antecedent basis of terms.

Applicants have amended claim 18 to correct a typographical error that resulted in claim 18 appearing to depend from itself. With the correction, claim 18 now depends from claim 17. Applicants have also amended each of claims 19-21 and 23-24 so that they depend from claim 17. Claim 22 has been amended to depend from claim 21. In addition, Applicants have further amended claims 18 and 20-22 in order to more clearly specify the relationships of the steps of the dependent claims to their respective base claim, as well as to ensure consistency of antecedent basis of terms.

No new matter has been added by way of any of the above-described amendments.

### **3. Response to Objections**

The Examiner objected claim 18 because it depended from itself, and the Examiner objected to claim 19-24 because they depend from claim 18. As noted above, the self-dependency of claim 18 was the result of a typographical error, which has been corrected by way of amendment. As amended, claim 18 now depends from claim 17. Also as noted, each of claims 19-21 and 23-24 has been amended to depend from claim 17, while claim 22 has been amended to depend from claim 21. Applicants respectfully request that the Examiner withdraw the objections to claim 18 and claims 19-24.

### **4. Response to Rejections under 35 U.S.C. § 102(e)**

The Examiner rejected claims 1-8, 10-11, and 13-16 under 35 U.S.C. § 102(e) as allegedly being anticipated by Poustchi (U.S. Patent Application Pub. No. 2004/0240656), which the Examiner also noted is based on parent provisional application No. 60/473,877 (hereafter, Poustchi-provisional). Applicants note that Poustchi has a filing date of May 24, 2004, more than five months after Applicants' filing date, while the filing date of Poustchi-provisional (May 29, 2003) predates Applicants' filing date by just over six months. Applicants submit that under M.P.E.P. § 2126.03, Poustchi is not entitled to the earlier filing date of the provisional application with respect to subject matter not disclosed in the provisional application. Consequently, all of Applicants arguments in the following discussion are made with respect to Poustchi-provisional<sup>1</sup>. Applicants submit that Poustchi-provisional fails to teach each and every element set forth in any of claims 1-8, 10-11, and 13-16, and in view of M.P.E.P. § 2131, each of

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<sup>1</sup> While the Examiner noted both the provisional application and the later-filed patent application in the present office action, it is not clear which of the two the Examiner was citing in the arguments presented in the office action. In their present response, any reference made by Applicants to a citation by the Examiner assumes that the Examiner was citing Poustchi-provisional.

these claims is therefore allowable. Applicants' arguments below are directed primarily to claims 1 and 11, with exceptions noted.

**a. Poustchi-provisional does not teach at a server “creating an association between the call park number and the second user agent by registering the call park number at the server.”**

Poustchi-provisional teaches a system and method for providing peer-to-peer call park and call park pickup. While Poustchi-provisional discloses by way of background a centralized system for delivering call park and call park pickup functionality (e.g., page 2, line 28 to page 4, line 8), it is unambiguous in teaching that call park and call park pickup functionality be carried out exclusively by peers. For example, in summarizing the purported invention, Poustchi-provisional teaches (page 4, lines 13-30):

One objective of the present patent is to *completely eliminate any central call processing intelligence*, by moving the processing intelligence, and any information that is normally held in a central location, *to the telephone sets*.

Another objective of the present patent is to define a method and apparatus for call park and call park pickup in a distributed *peer-to-peer telephony* system and thus *eliminate any central call processing intelligence*.

... conventional models of call park and call park pickup using central call processing equipment *are no longer valid in such a distributed peer-to-peer telephony system*. (Emphasis added.)

Poustchi-provisional teaches that peers are packet-based telephones (e.g., page 4, lines 1-21). Poustchi-provisional *does not teach* that any device other than a telephone set, whether it be central call processing equipment or a network server, plays any part in delivering call park and pick-up functionality to user devices in a network telephony system of the purported invention. The only possible way that central call processing intelligence could be combined with the purported invention of Poustchi-provisional so as to even remotely resemble Applicants' invention would be to *modify* Poustchi-provisional in a manner contradictory to the teachings therein (see section 5 of this response for further arguments with respect to the disclosure, made

by way of background, of central call processing equipment in Poustchi-provisional).

In contrast to Poustchi-provisional, Applicants' claims 1 and 11 both expressly recite *at a server* "creating an association between the call park number and the second user agent by registering the call park number at the server." Interpreted in view of Applicants' specification, a server plays a role that is distinct from that of the user agents recited in claims 1 and 11. In particular, it provides for registration of the entered call park number, the registration serving to create an association between the call park number and the second user agent (the entity at which the call park number was entered). The teachings of Poustchi-provisional leave no room to interpret a server as a peer in the disclosed system and method. Applicants thus submit that Poustchi-provisional fails to teach the presently-cited element of Applicants' claims 1 and 11.

**b. Poustchi-provisional does not teach "using the association between the call park number and the second user agent" for "establishing a second communication session between the third user agent and the second user agent" or for "routing the call from the third user agent to the second user agent."**

For reasons similar to those discussed above, Poustchi-provisional fails to teach any role for a server in being the source of information that is used to establish a second communication session between the third user agent and the second user agent.

In contrast, claim 1 expressly recites "establishing a second communication session between the third user agent and the second user agent *using the association between the call park number and the second user agent*, the association being obtained from the server" (emphasis added). Similarly, claim 11 expressly recites "at the server, routing the call from the third user agent to the second user agent *using the association between the call park number and the second user agent*," a step that is followed by establishing a second communication session between the third user agent and the second user agent (emphasis added). Poustchi-provisional does not teach either of these similar claim limitations, because Poustchi-provisional does not

teach a server playing any role in call park or call pick-up.

**c. Poustchi-provisional does not teach “deregistering the call park number at the server.”**

Again, because Poustchi-provisional does not teach a server playing any role in call park or call pick-up, Poustchi-provisional cannot teach this limitation of both claims 1 and 11.

In addition to the failure of Poustchi-provisional to teach the similar limitations of claims 1 and 11 discussed above, Applicants further submit that, with respect to claim 11, **Poustchi-provisional does not teach “at the server, authorizing the second user agent for call parking.”**

More specifically, Poustchi-provisional fails to teach authorization of *parking a call*. At most, Poustchi-provisional teaches that an *already-parked* call cannot later be *picked up* if an invalid ParkID is entered at the peer device from which the *pick-up* operation is invoked. As disclosed at page 20, lines 10-31 and illustrated in Figure 8 of Poustchi-provisional, if a user, *after* successfully parking a call at terminal set 100-2, attempts to *pick up* the call at terminal set 100-7 using an invalid ParkID, an error message will be sent to terminal set 100-7. The disclosed steps are unrelated to authorization for *parking* a call.

In contrast, claim 11 expressly recites, “at the server, authorizing the second user agent *for call parking*” (emphasis added). Thus, in addition to failing to teach a server, as discussed above, Poustchi-provisional also fails to teach authorizing call parking.

For at least the reasons discussed above, Applicants submit that Poustchi-provisional fails to anticipate either claim 1 or claim 11, and that both claim 1 and claim 11 are therefore allowable.

Each of claims 2-6, 8, 10, and 13-16 depend, in one way or another, from one of the independent base claims (claims 1 and 11), both of which are allowable for at least the reasons

discussed above. Applicants submit that for at least the reason that they depend from an allowable claim, claims 2-6, 8, 10, and 13-16 are therefore allowable as well. Further, Applicants do not concede any specific assertions made by the Examiner with respect to any of claims 2-6, 8, 10, and 13-16.

## **5. Response to Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 9, 12, and 17-24 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Poustchi and Schulzrinne. For reasons discussed above, only Poustchi-provisional is considered in the following discussion.

In order to establish a *prima facie* case of obviousness of a claimed invention by applying a combination of references, the prior art must teach or suggest all of the claim limitations. M.P.E.P. § 2143. Applicants submit that, as discussed below, Poustchi-provisional fails to teach specific limitations of each of claims 9, 12, and 17-24 beyond those limitations acknowledged by the Examiner to be missing from Poustchi-provisional. Further, Schulzrinne does not make up for the deficiencies of the specific claim limitations that either Applicants submit are missing from Poustchi-provisional, or the Examiner acknowledges are missing from Poustchi-provisional. Thus, as discussed below, the combination of Poustchi-provisional and Schulzrinne fails to teach or suggest all of the claim limitations of any of claims 9, 12, and 17-24. Moreover, Applicants submit that there could have been no motivation to combine the cited references at the time of Applicants' invention. Hence the Examiner has not established a *prima facie* case of obviousness. The arguments below are made with respect to independent claim 17, but apply to claim 18-24 as well. Claims 9 and 12 are discussed separately.

First, with regard to Applicants' argument in section 4 (above) of the present response that Poustchi-provisional fails to teach a server playing any role in call park and call pick-up

functionality, Applicants note that in rejecting claims 1 and 11, the Examiner cited Poustchi-provisional as teaching “central equipment parks the call.” Applicants pointed out above that the “central call processing equipment” is disclosed by way of background in Poustchi-provisional, and is further disclosed as “no longer valid” in the “peer-to-peer telephony system” of the purported invention. In other words, Poustchi-provisional *very clearly* teaches away from using central call processing intelligence for call park and call pick-up. While Applicants acknowledge that this teaching away does not by itself remove the central-call-processing-intelligence-based model of call park and call pick-up disclosed in Poustchi-provisional from consideration as prior art, Applicants submit that this teaching away *does* preclude combining the central-call-processing-intelligence-based model with the peer-to-peer approach advocated by Poustchi-provisional.

Put a different way, by teaching *away* from one model of call park and call pick-up, and *advocating* another model instead, Poustchi-provisional necessarily is at most teaching one *or* the other, but *cannot be teaching a combination of both*. Yet in rejecting claims 1 and 11, the Examiner indeed combined *both* the purported invention disclosed in Poustchi-provisional, as well as the previous approach disclosed by way of background in Poustchi-provisional – an approach that, according to Poustchi-provisional, would not be valid in combination with the purported invention. Applicants submit that the Examiner’s rejections of claims 1 and 11 do not merely cite disclosures in Poustchi-provisional alleged to be prior art, but necessarily require a *modification* of Poustchi-provisional that is not only inconsistent with the purported invention therein, but precluded by it as well. Applicants therefore maintain that, as argued above, Poustchi-provisional fails to teach a server playing any role in call park and call pick-up functionality in a manner as recited in claims 1 and 11.



With regard to claim 17, the Examiner conceded that Poustchi-provisional fails to teach a SIP proxy server, but asserted that Schulzrinne makes up for this deficiency. Applicants submit that Poustchi-provisional fails to teach additional limitations of claim 17, besides just that of a SIP proxy server. In particular, claim 17 recites limitations that are similar to those of claims 1 and 11 discussed above, and Applicants submit that their arguments above with respect to claims 1 and 11 apply to claim 17 as well. Thus, in addition to failing to teach a SIP proxy server, Poustchi-provisional also fails to teach at least the limitations of claim 17 that are similar to those discussed in connection with claims 1 and 11. Applicants further submit that, other than the disclosure of a SIP proxy server, Schulzrinne fails to make up for any of the deficiencies of Poustchi-provisional with respect to claim 17.

Applicants also submit that because Poustchi-provisional so clearly teaches away from using a server, as discussed above, one of ordinary skill in the art would not have been motivated at the time of Applicants' invention to combine Schulzrinne with Poustchi-provisional in order to introduce a SIP proxy server. Applicants therefore submit that the Examiner's assertion to the contrary is not only unsupported, but contradicted by the teachings of Poustchi-provisional. Moreover, in accordance with M.P.E.P. § 2143.02, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious." Since, as discussed above Poustchi-provisional teaches "[o]ne objective of the present patent is to completely eliminate any central call processing intelligence," the Examiner's proposed combination with Schulzrinne would surely "change the principle of operation" taught in Poustchi-provisional.

For at least the reasons discussed above, Applicants submit that the combination of

Poustchi-provisional and Schulzrinne fails to teach or suggest all of the limitation of claim 17, and that claim 17 is therefore allowable as well.

Each of claims 18-24 depend, in one way or another, from claim 17, which is allowable for at least the reasons discussed above. Applicants submit that for at least the reason that they depend from an allowable claim, claims 18-24 are therefore allowable as well. Further, Applicants do not concede any specific assertions made by the Examiner with respect to any of claims 18-24.

Each of claims 9 and 12 depend from one or the other of independent base claims 1 and 11, both of which are allowable for at least the reasons discussed above. Applicants submit that for at least the reason that they depend from an allowable claim, claims 9 and 12 are therefore allowable as well. Further, Applicants do not concede any specific assertions made by the Examiner with respect to any of claims 9 and 12.

## **6. Conclusion**

Applicants submit that the application is in good and proper form for allowance and therefore respectfully request favorable reconsideration. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned patent agent, at 312-913-3353.

Respectfully submitted,

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